

REMARKS

Applicants submit this Reply in response to the Office Action mailed February 1, 2010. Claims 21-40 are currently pending, of which claims 21 and 37 are independent.

In the Office Action, the Examiner rejected claim 40 under 35 U.S.C. § 101 for allegedly being directed to non-statutory subject matter.¹ In addition, the Examiner rejected claims 21-28, 32, and 37-40 under 35 U.S.C. § 103(a) as allegedly being unpatentable over U.S. Patent No. 6,522,888 ("Garceran") in view of U.S. Patent Publication No. 2007/0135134 ("Patrick"). Finally, claims 29-31 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Garceran in view of Patrick and further in view of U.S. Patent Publication No. 20040156372 ("Hussa"), while claims 33-36 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Garceran in view of Patrick and further in view of U.S. Patent Publication No. 20030125046 ("Riley").

With this Reply, Applicants have amended claims 21, 37, and 40. Applicants' originally-filed specification provides support for these amendments at, for example, page 14, line 32 to page 15, line 3. No new matter has been added.

Applicants respectfully traverse all pending rejections for at least the reasons discussed below.

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The Office Action contains a number of statements characterizing Applicants' disclosure, including the claims, and the related art. Regardless of whether any such statement is specifically addressed herein, Applicants decline to automatically subscribe to any statement or characterization in the Office Action.

Rejection of Claims 9-18 Under 35 U.S.C. § 101

Claim 40 stands rejected under 36 U.S.C. § 101 for allegedly being directed to non-statutory subject matter. More specifically, the Office Action asserts that the recitation of “a computer-readable medium storing instructions for execution by a processing system . . .” in claim 40 “covers a transitory signal” because “the specification did not [sic] show and/or describe any example and/or what the ‘Computer readable medium’ covers. . . . Therefore the claim embraces subject matter that is not eligible for patent protection under 35 U.S.C. § 101.” Office Action, p. 3.

First, Applicants note that, as previously pointed out in the Amendment filed on November 12, 2009, the recitation of “[a] computer-readable medium” is supported expressly, implicitly, or inherently by the specification at, for example, p. 12, lines 5-7. Second, without conceding to the Office Action’s allegations, Applicants have amended claim 40 to recite “[a] non-transitory computer-readable medium storing instructions for execution by a processing system” See *Subject Matter Eligibility of Computer Readable Media*, 1351 Off. Gaz. Pat. Office 212 (February 23, 2010) (“A claim drawn to such a computer readable medium that covers both transitory and non-transitory embodiments may be amended to narrow the claim to cover only statutory embodiments to avoid a rejection under 35 U.S.C. § 101 by adding the limitation “non-transitory” to the claim. Such an amendment would typically not raise the issue of new matter, even when the specification is silent because the broadest reasonable interpretation relies on the ordinary and customary meaning that includes signals *per se*.”) (internal citations omitted).

Applicants therefore respectfully request withdrawal of the 35 U.S.C. § 101 rejection of claim 40.

Rejections of Claims 21-28, 32, and 37-40 Under 35 U.S.C. § 103(a)

Applicants respectfully traverse the rejection of claims 21-28, 32, and 37-40 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,522,888 (“Garceran”) in view of U.S. Patent Publication No. 2007/0135134 (“Patrick”). The Office Action has not properly resolved the *Graham* factual inquiries, the proper resolution of which is the requirement for establishing a framework for an objective obviousness analysis. See M.P.E.P. § 2141(II), citing to *Graham v. John Deere Co.*, 383 U.S. 1, 148 U.S.P.Q. 459 (1966), as reiterated by the U.S. Supreme Court in *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 82 U.S.P.Q.2d 1385 (2007).

While Applicants have amended independent claims 21 and 37 to further demonstrate the differences between Garceran and the claims, Applicants maintain that the Office Action has not properly ascertained the differences between the claims and the references, at least because it has not interpreted the references and considered both the claims and the prior art as a whole. See M.P.E.P. § 2141(II)(B). Accordingly, the Office Action has not clearly articulated a reason why the claimed invention would have been obvious, which is “[t]he key to supporting any rejection under 35 U.S.C. 103.” M.P.E.P. § 2143.

Independent claim 21, as amended, calls for a combination including, for example,

associating each of a plurality of locating procedures with a different combination of at least one of the plurality of configuration data base entries and at least one of the plurality of measuring data types, wherein each of the plurality of locating procedures is configured to

estimate a position of the terminal based on the associated combination and corresponds to an accuracy value of the estimated position.

Amended independent claim 37, while of different scope than amended independent claim 21, contains similar recitations. Applicants respectfully submit that none of Garceran and Patrick, either alone or in combination, teaches or suggests at least these features of amended independent claims 21 and 37.

Garceran generally discloses “a system for determining [radio frequency (“RF”)] coverage in a wireless communications systems using location information for [a] wireless unit.” Garceran, col. 3, ll. 5-6. Garceran further discloses that

While a wireless unit is communicating with a base station, the RF coverage system can dynamically determine RF coverage using the location information from the wireless unit in association with additional information and/or measurements, such as signal quality measurements which can include received signal strength (RSSI), bit error rate (BER), and/or frame error rate (FER), made at the wireless unit and/or at the receiving base station(s), and/or other information or parameters, such as operating conditions, mobile identity, traffic load, frequency, speed, direction, time and/or mobile/type.

Id. at col. 3, ll. 15-25. More specifically, Garceran discloses that “using the location of the wireless unit and collecting associated or corresponding data for the wireless unit at that location, the wireless communication system 50 can produce an RF database . . . to represent or provide an RF coverage map for a geographic region.” *Id.* at col. 3, ll. 26-30. “The location information and/or associated information [is] transmitted to the serving base station from the wireless unit.” *Id.* at col. 4, ll. 1-2.

In rejecting independent claims 21 and 37, the Examiner appears to equate Garceran’ s disclosure of the location information transmitted from the wireless unit to the serving base station to the claimed “plurality of locating procedures” because Garceran’s location information is associated with corresponding signal quality

measurements to produce an RF coverage database. See Office Action, p. 5; p. 8.

This reasoning is incorrect. As shown above, instead of disclosing how the location information of the wireless unit is generated, Garceran merely discloses that a database containing an RF coverage map for a region is generated based on the wireless unit's location information and collected signal quality measurements. Garceran, col. 3., ll. 15-30. Indeed, Garceran provides no detail about how the wireless unit determines its location information. Garceran only discloses that its location information is transmitted to a serving base station. See *id.* at col. 4, ll. 1-2. Accordingly, Garceran does not teach or suggest

associating each of a plurality of locating procedures with a different combination of at least one of the plurality of configuration data base entries and at least one of the plurality of measuring data types, **wherein each of the plurality of locating procedures is configured to estimate a position of the terminal based on the associated combination** and corresponds to an accuracy value of the estimated position.

as required by Applicants' amended independent claims.

The Office Action's application of Patrick does not cure the above-referenced deficiencies of Garceran. More specifically, the Office Action alleges that Patrick "teaches that the locating system . . . is located remotely from the terminal . . . and the plurality of base stations." Office Action, p. 5 (internal citations omitted). Even assuming the Office Action's characterizations of Patrick are correct, which Applicants do not concede, Patrick still does not teach or suggest the above-referenced elements of amended independent claims 21 and 37.

As set forth above, neither Garceran nor Patrick teach or suggest every feature of Applicants' amended independent claims 21 and 37. Consequently, the Office Action

has not properly ascertained the differences between the references and the rejected claims. Accordingly, no reason has been articulated as to why the claims would have been obvious to one of ordinary skill in the art. For at least this reason, claims 21 and 37 should be allowable. Claims 22-28, 32, and 38-40 depend from one of allowable independent claims 21 and 37 and should be allowable at least due to their dependence from these base claims. Therefore, for at least the foregoing reasons, Applicants respectfully request withdrawal of the section 103 rejection of pending claims 21-28, 32, and 37-40.

Rejection of Claims 29-31 and 33-36 Under 35 U.S.C. § 103(a)

Applicants respectfully traverse the rejection of claims 29-31 under 35 U.S.C. § 103(a) as being unpatentable over Garceran in view of Hussa and the rejection of claims 33-36 under 35 U.S.C. § 103(a) as being unpatentable over Garceran in view of Riley.

Applicants have already established that Garceran and Patrick do not teach or suggest at least the above-referenced element of amended independent claim 21 and as required by each of dependent claims 29-31 and 33-36. Moreover, the Office Action's application of Hussa and Riley fails to cure the above-noted deficiencies of Garceran.

More particularly, the Office Action alleges that

Hussa teaches transferring, to the terminal of the network (mobile based positioning), . . . , processing programs for performing at least one subset of locating procedures . . . , and at least one subset of said plurality of configuration data base entries (base station coordinates) used by the transferred locating procedures . . . , whereby the location estimation is performed by the terminal and information about estimated position and estimation accuracy are transmitted from the terminal to a locating system upon every service request.

Office Action, p. 9 (internal citations omitted). The Office Action further alleges that “Hussa teaches the terminal performing signal measurement and calculates the location estimation.” *Id.* at p. 10. Regarding Riley, the Office Action alleges that “Riley teaches estimates [sic] the position of the terminal corresponding to the barycenter (centroid) coordinates of the coverage area of said base station and an uncertainty value, the uncertainty value being defined by the distances from said barycenter to all points of the coverage area.” *Id.* at p 12 (internal citations omitted).

Even assuming that the Office Action’s characterizations of Hussa and Riley are correct, which Applicants do not concede, neither Hussa nor Riley teach or suggest the above-referenced element of amended independent claim 21 and as required by each of dependent claims 29-31 and 33-36. Accordingly, the cited references, taken either alone or in any reasonable combination, fail to teach or suggest all the recitations of claims 29-31 and 33-36. Thus, the Office Action has not articulated a reason why the claims would have been obvious to one of ordinary skill in the art and no *prima facie* case of obviousness has been established with respect to claims 29-31 and 33-36.

Conclusion

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.


Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account 06-0916.

Respectfully submitted,

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GARRETT & DUNNER, L.L.P.

Dated: May 4, 2010

By: _____

A handwritten signature in black ink, appearing to read "R. Bruce Bower", is written over a horizontal line.

R. Bruce Bower
Reg. No. 37,099